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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/710,999	11/09/2000	Tetsunosuke Fujisaki	YO999-527	5835

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EXAMINER

SUBRAMANIAN, NARAYANSWAMY

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 12/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/710,999	FUJISAKI, TETSUNOSUKE	
	<b>Examiner</b>	<b>Art Unit</b>	
	Narayanswamy Subramanian	3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5, 17-21 and 32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 17-21 and 32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This office action is in response to applicant's communication filed on October 18, 2004. Amendments to the specification and claims 1, 17 and 32, and cancellation of claims 6-16, 22-31 and 33-36 have been entered. Rejection of claims 17-21 under 35 USC § 112, second paragraph made in the last office action have not been addressed by the Applicants in their communication and hence these rejections have been repeated in the present office action. Claims 1-5, 17-21 and 32 are pending in this application and have been examined. The rejections and response to arguments are stated below.

#### ***Claim Rejections - 35 USC § 101***

2. The claims 1-5 of the invention are rejected under 35 USC § 101 because they are directed to non-statutory subject matter. Claim 1 is drawn to a method for processing transactions involving financial securities that is not tied to any technological art. Similarly the dependent claims 2-5 are not tied to any technological art. Claims 1-5 are directed to non-statutory subject matter because they lack any recitation of technology in the body of the claims, which is required in order to meet the statutory requirements. The Patent Office has taken the position that some form of technology must be claimed in the body of the claim. The Board of Patent Appeals and Interferences has stated that claims lacking any technology are "nothing more than [an] abstract idea which is not tied to any technological art and is not a useful art as contemplated by the Constitution." *Ex parte Bowman*, 61 USPQ2d 1669, 1671 (Board Pat. App. & Inter. 2001) (Unpublished). While it is understood that the Bowman case is not precedential, it is cited herein for its content and reasoning.

The substance of this rejection is that the method for processing transactions involving financial securities that is not tied to any technological art. The Patent Office has taken the position that some form of technology must be claimed in the body of the claim. Applicants' arguments that the claimed invention provides useful, concrete and tangible result does not address the point made by the examiner, namely lack of technological art in the body of the claims. Hence the rejection is maintained.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

4. Claims 17-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 17 cites in the preamble "system for processing transactions involving financial securities". It is not clear if the claimed invention is a method or an apparatus. Claims 18-21 are rejected because they depend on the rejected claim 17. Clarification is required.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-5, 17-21 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woolston (US Patent 6,266,651 B1) in view of Silverman et al (US Patent 5,924,082).

With reference to claims 1, 17 and 32, Woolston teaches a method, a system and an article of manufacture respectively for processing transactions in a secondary market, the method comprising the steps of: establishing a plurality of market segments in said secondary market, each of said market segments having at least one market participant (See Woolston Column 1 lines 51-67, the tiers constitute the market segments and used goods imply secondary markets); receiving a bid for one or more goods, said bid including one or more authorized market segments (See Woolston claim 35, receiving bids from retail segment is implied in the disclosure); and posting said bid only to said one or more authorized market segments (See Woolston claims 5 and 18, privileges available to only one segment is interpreted to include this feature). A system for processing transactions, comprising a memory that stores computer-readable code and a processor operatively coupled to said memory and an article of manufacture comprising a computer readable medium having computer readable code means embodied thereon are inherent in the disclosure of Woolston. The Dictionary of Banking Terms defines “a secondary market as the market where existing loans, .... and other assets are sold to investors, either directly or through an intermediary”. Hence the market for used goods and collectibles disclosed in Woolston qualifies as a secondary market.

Woolston does not teach the feature wherein the goods are financial securities.

Silverman teaches the feature wherein the goods are financial securities (See Silverman Column 3 lines 50-55).

Both Woolston and Silverman are concerned with the problem of processing transactions involving two parties. It would have been obvious to one with ordinary skill in the art at the time the invention was made to include the feature taught by Silverman to the disclosure of Woolston.

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The combination of the teaching taken as a whole suggests that parties to the transaction would have benefited from being able to communicate and negotiate other terms with each other before finalizing the transaction.

With reference to claims 2, 3, 18 and 19, Woolston teaches the steps of preventing said bid from being posted to market participants not in said one or more authorized market segments (See Woolston Claims 5 and 18, privileges available to only one segment is interpreted to include the step of preventing said bid from being posted to market participants not in said one or more authorized market segments) and the step of comparing said bid to other pending bids to identify pending bids that are in proximity to said received bid (See Woolston claim 35, selectively displacing a bid implies comparing said bid to other pending bids to identify pending bids that are in proximity to said received bid).

With reference to claims 4 and 20, Silverman teaches the step of establishing a communication channel between entities associated with two bids that are in proximity (See Silverman Column 3 lines 40-44 and 60-64).

With reference to claims 5 and 21, Silverman teaches the step wherein two bids are in proximity if they have parameters that are within a given threshold of each other (See Silverman Column 4 lines 35-47).

### ***Response to Arguments***

7. Examiner disagrees with the Applicant's assertion that the secondary market for financial securities is substantially different from the marketplace for used and collectible goods disclosed by Woolston. For instance secondary markets for very illiquid securities are no different from the secondary markets for used and collectible goods.

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In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "a market segment as a group of other market participants to which the respective market participant is willing to announce its bids") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant's other arguments with respect to claims 1, 17 and 32 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(a) Thomas P. Fitch "Dictionary of Banking Terms" Barrons Publishers (Fourth Edition)

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

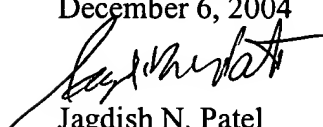
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

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calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (703) 305-4878. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065. The fax number for Formal or Official faxes and Draft to The Patent Office is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

N. Subramanian  
December 6, 2004

 12/9/04  
Jagdish N. Patel  
Primary Examiner